



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/356,771	07/16/1999	JOSEPH E. PORCELLI	1310-2	8276
81099	7590			
Thomas M. Galgano 20 W. Park Avenue Suite 204 Long Beach, NY 11561				
EXAMINER				
DUCKWORTH, BRADLEY				
ART UNIT		PAPER NUMBER		
3632				
MAIL DATE		DELIVERY MODE		
07/14/2012		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH E. PORCELLI

Appeal 2010-010359
Application 09/356,771
Technology Center 3600

Before JOHN C. KERINS, CHARLES N. GREENHUT, and
PATRICK R. SCANLON, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Joseph E. Porcelli (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 18 and 20-22. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

THE INVENTION

Appellant's invention is directed to beverage container holders having resilient, V-shaped fingers for accommodating a variety of beverage containers. Spec. p. 4, l. 14-p. 5, l. 2. Claims 18 and 21, reproduced below, are illustrative of the subject matter on appeal.

18. A beverage container holder for round and square beverage containers, comprising:

a rectangular basket having four side walls, each having a top edge border which collectively define an open top end and which, in turn, defines a rectangular opening, at least two of said side walls disposed opposite one another each having at least one opening therethrough disposed beneath said top edge border thereof; and

at least four resilient, V-shaped, flat fingers, each having an upper fixed end which is coupled to said top edge border of said rectangular basket and a lower free end extending generally downward into one of said side wall openings of said rectangular basket, said fingers each defining a point of a V between said ends thereof and having a V-shaped profile when viewed in a vertical plane with the point of the V extending radially inwardly generally towards the center of the rectangular opening, said fingers forming a biasing structure for releasably supporting a

beverage container when inserted into said rectangular basket and cooperating to resiliently and releasably grasp both round and square beverage containers; and

a generally V-shaped hook attached to and extending above said basket, wherein

said rectangular basket, said at least four resilient fingers and said generally V-shaped hook are formed as a single unitary member.

21. A beverage container holder for round and square beverage containers, comprising:

a rectangular tray having a top wall having a pair of spaced-apart rectangular openings; and

at least two sets of four resilient, V-shaped, flat fingers, each having an upper fixed end which is coupled to said top wall of said rectangular tray and a lower free end extending inwardly toward a different one of said rectangular openings, said fingers each defining a point of a V between said ends thereof and having a V-shaped profile when viewed in a vertical plane with the point of the V extending radially inwardly generally towards the center of the respective rectangular opening, said fingers of each set forming a biasing structure for releasably supporting a beverage container when inserted into said rectangular basket and cooperating to resiliently and releasably grasp both round and square beverage containers; and

a supporting member rotatably coupled to said rectangular tray and being pivotable into a position located below said pair of rectangular openings.

THE REJECTIONS

Appellant seeks review of the following rejections:

1. Claims 18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartmann (US 5,938,160, issued Aug. 17, 1999) in view of Jackson (US D228,335, issued Sept. 11, 1973) and further in view of Bieck (US 5,839,711, issued Nov. 24, 1998).
2. Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller (US 5,297,767, issued Mar. 29, 1994) in view of Jackson and further in view of Bieck.
3. Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Jackson and Bieck and further in view of Pratt (US 4,530,480, issued July 23, 1985).

ISSUES

Did the Examiner err in concluding that it would have been obvious to one skilled in the art at the time the invention was made to modify the container holder of Hartmann in view of the teachings of Jackson and Bieck?

Did the Examiner err in concluding that it would have been obvious to one skilled in the art at the time the invention was made to modify the container holder of Miller in view of the teachings of Jackson and Bieck?

ANALYSIS

1. *Rejection of claims 18 and 20 based on Hartmann, Jackson and Bieck*

With respect to independent claim 18, the Examiner finds that Hartmann discloses all of the claimed limitations except for the basket being

rectangular and the fingers being V-shaped. Ans. 4. The Examiner maintains that Jackson teaches a rectangular holder that can hold either rectangular or cylindrical beverage containers and concludes that it would have been obvious to one of ordinary skill in the art at the time of invention to make the holder of Hartmann rectangular. *Id.* The Examiner further maintains that Bieck teaches a cup holder with resilient, V-shaped fingers and concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to make the flat, resilient fingers of Hartmann V-shaped as taught by Bieck. *Id.*

Appellant argues that there is no reason provided in Hartmann to make either of these modifications. App. Br. 13. However, a reason to modify a reference does not have to originate from the reference being modified. The rationale for combining references can be gleaned from a variety of sources. *See DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006) (“The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.”). The Examiner reasons that changing the holder’s shape to rectangular would allow the holder to hold circular and rectangular containers, and that the proposed modification was an obvious design choice as holders of different shapes perform substantially the same function in substantially the same manner. Ans. 7. We find no error in this conclusion. We agree that one of ordinary skill in the art would recognize that a rectangular beverage holder could hold both rectangular and circular beverage containers. We further agree that making the round

beverage holder rectangular would have been a predictable variation of Hartmann's beverage holder to perform substantially the same function in substantially the same manner. See *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007) ("If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.").

Appellant also argues that there is no reason to modify Hartmann in view of Jackson because "Jackson solves the problem of accommodating round and square beverage containers by providing rounded sides of the rectangular frame." App. Br. 14. We are not persuaded by this contention. While Jackson does show rounded sides, there is no indication that this is done to solve the problem of accommodating round and square beverage containers. Moreover, whether Jackson provides rounded sides to accommodate both round and square beverage containers or for some other reason does not detract from the fact that the reference discloses a rectangular beverage container.¹ Jackson's teaching of a rectangular beverage holder is applicable regardless of the reason for making the holder rectangular. "One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings." *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323 (Fed. Cir. 2005).

Appellant asserts that the fingers of Bieck i) are not V-shaped, ii) do not define a point of a V between the ends thereof, iii) are not flat, and iv)

¹ We note that Appellant does not assert that Jackson's holder is non-rectangular because of the slightly rounded side portions. Indeed, Appellant refers to the frame of Jackson's holder as "the rectangular frame." App. Br. 14.

do not have an upper fixed end and a lower free end. App. Br. 15. The Examiner does not rely on Bieck for a teaching of fingers that are flat or have a fixed upper end and a free lower end. The Examiner finds the fingers of Hartmann have these features. Ans. 4. We agree with the Examiner that the fingers of Hartmann are flat² and have a fixed upper end and a free lower end.

The Examiner takes the position that the holding jaws 20 of Bieck are V-shaped fingers, stating “inclined surface (28) and surface (30, lower 30) [form] the legs of the V.” Ans. 7. In response, Appellant argues that “V-shaped” means “two inclined faces meeting at a single point,”³ which the holding jaws 20 of Bieck do not have. Reply Br. 5. We disagree that the holding jaws 20 of Bieck do not meet Appellant’s definition. As described in column 2 of Bieck, each holding jaw 20 has an inclined surface 28 that faces upward and two supporting surfaces 30 located in approximate secant planes of the container receptacle 12. Figure 2 clearly shows the inclined surface 28 and the lower supporting surface 30 meet at a point.

Moreover, we find nothing to support Appellant’s narrow definition of “V-shaped.” During patent examination, claims are given their broadest

² Given that the fingers of the present invention have a V-shaped front side defined by two planar surfaces intersecting at an obtuse angle and a concave back side, and given that the Specification does not even use the term “flat” in describing the fingers, it is not entirely clear in what sense these fingers are flat. Nevertheless, we consider the fingers of Hartmann to be at least as flat as the fingers of the present invention.

³ Although Appellant refers to the intersection of the inclined faces as a “point,” we note that this intersection actually defines a line as shown in Figures 2 and 3. Because we believe Appellant is using “point” in this context in a broad general sense, we follow this usage herein.

reasonable construction in light of the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005). The only discussion in Appellant's Specification regarding the shape of the fingers is that they assume "a generally V-shaped configuration." Spec. 8. This description does not support the particular meaning of "V-shaped" now being asserted by Appellant. We determine that the broadest reasonable interpretation of "V-shaped" means having a shape resembling the letter V. The holding jaws 20 of Bieck have a shape that resembles a V. We accordingly agree with the Examiner that the holding jaws 20 of Bieck are V-shaped fingers.

Appellant further argues that the holding jaws 20 of Bieck cannot be V-shaped because each has *two* of the supporting surfaces 30. Reply Br. 5. We are not persuaded by this argument because the claim language does not require the entire body of the finger to define a V-shape. The lower portion of each holding jaw 20 is V-shaped as discussed above.

Regarding the point-of-a-V limitation, the Examiner contends that "a point of a V" could be any point on the V-shaped portion of Bieck's holding jaw. Ans. 7. Appellant counters that there are no points on Bieck's holding jaw that point inward because the inner supporting surfaces are flat. Reply Br. 6. The phrase "a point of a V" does not appear in Appellant's Specification and there is nothing to ascribe any particular meaning to the phrase other than its plain meaning. Applying the broadest reasonable interpretation, we find that "a point of a V" does not necessarily mean the vertex of the V and agree with the Examiner that any point on the V-shaped portion could be "a point of a V." Moreover, given Appellant's comment that a "point" is a geometric element having zero dimensions, it is difficult

to envision how a point can extend in any direction. Nevertheless, each holding jaw 20 of Bieck has an inclined surface 28 that meets the lower supporting surface 30 at a point which is disposed inside the container receptacle 12. We thus conclude that Bieck discloses a point on the V-shaped portion of each holding jaw 20 that extends radially inward toward the center of the container receptacle 12 in the same sense that the points of Appellant's fingers extend radially inward. Clearly, the V-shaped portions of the holding jaws extend radially inward in the same manner as Appellant's V-shaped fingers.

Appellant also argues that it is improper to combine Hartmann with Jackson and Bieck because there is nothing suggesting the desirability of such a combination, citing *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992). App. Br. 14, 15, 17-18. The *Fritch* case states:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner.

Fritch, 972 F. 2d at 1266 (footnote omitted) (emphasis added). The court further stated "there is no teaching, suggestion, or incentive in the prior art to modify or to combine the teachings of the prior art in the manner suggested by the Examiner." *Id.* At 1265. Accordingly, *Fritch* uses desirability interchangeably with teaching, suggestion, or motivation. Since the *Fritch* decision, the Supreme Court has made clear that there is no requirement for an actual teaching, suggestion, or motivation in the references themselves to combine. *KSR*, 550 U.S. at 419 ("Helpful insights, however, need not

become rigid and mandatory formulas; and when it is so applied, the [teaching-suggestion-motivation] test is incompatible with our precedents.”). Even if we were to agree with Appellant that the prior art does not suggest the desirability of combining the references in the manner set forth by the Examiner, we would still conclude that there is a rational underpinning supporting the Examiner’s conclusion of obviousness. We agree with the Examiner that that it would have been obvious to one of ordinary skill in the art at the time of invention to make the holder of Hartmann rectangular in view of the teaching of Jackson and to make the flat, resilient fingers of Hartmann V-shaped as taught by Bieck. *See Id.* at 416 (combining elements found in the prior art “according to known methods is likely to be obvious when it does no more than yield predictable results”).

Appellant notes the relative complexity of Bieck’s holding jaws and asserts that it would not have been obvious to combine Hartmann with Bieck because the biasing structures in these references operate in completely different manners. Reply Br. 6-7. While the resilient fingers 16 of Hartmann and the holding jaws 20 of Bieck are not identical, we disagree that these elements “operate in completely different manners.” There is sufficient similarity in the purpose and manner of operation of these elements to suggest the combination to a person of ordinary skill in the art. *See Id.* at 420 (“Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.”). We are also not swayed by the alleged complexity of Bieck’s holding jaws. The basis of the Examiner’s rejection

is that it would have been obvious to modify the resilient fingers of Hartmann (which have a fixed upper end and a free lower end) by making them V-shaped per the teaching of Bieck. The Examiner is not proposing to replace the fixed upper end fingers of Hartmann with the sliding holding jaws of Bieck. Therefore, the relative complexity of the Bieck arrangement does not detract from the fact that Bieck suggests V-shaped fingers.

Lastly, Appellant argues that the Examiner relies on improper hindsight in combining the references. App. Br. 17, Reply Br. 7. For the reasons discussed above, we determine that the Examiner's conclusion of obviousness is based on the knowledge of persons of ordinary skill in the art at the time of the invention and is not improperly derived from Appellant's Specification. Accordingly, we disagree that the rejection relies on improper hindsight.

For the reasons discussed above, we sustain the rejection of claim 18 as being obvious over the combination of Hartmann, Jackson and Bieck. We also sustain the rejection of claim 20, which depends from claim 18 and for which Appellant does not advance any separate arguments.

2. *Rejection of claim 21 based on Miller, Jackson and Bieck*

The Examiner contends that the first embodiment of Miller (shown in Figures 1-6) discloses a beverage container comprising a rectangular tray having a pair of spaced apart openings, with each opening having a set of four inwardly extending, flat resilient members, and a support comprising rotatable support members that can be positioned below the openings. Ans. 5. We disagree that the first embodiment includes a supporting member that

meets the recitation of claim 21. Specifically, claim 21 recites a supporting member that can be pivoted into a position below both of the tray openings. The Examiner argues “the claims do not limit the number of support members,” and “the number of support members in the reference is irrelevant as long as it at least has the one claimed support member.” Ans. 8. While these statements may be technically true, Miller does not show one supporting member that can be positioned below both openings, as required by claim 21, and thus lacks the “one claimed support member.” Miller shows a first supporting member 38 that can be pivoted into a position below a first opening 31 and a second supporting member 48 that can be pivoted into a position below a second opening 41. Neither supporting member can be positioned below both openings 31 and 41. Thus, the first embodiment of Miller, even when modified by Jackson and Bieck in the manner set forth by the Examiner, does not include all of the elements of claim 21.

Although not relied on by the Examiner, we note that the second embodiment of Miller (shown in Figures 7-10) includes a beverage container having two spaced apart openings and a single support member 100 that pivots to a position below both openings. Miller, col. 3, ll. 54-63. The second embodiment of Miller also includes inwardly extending, flat resilient members or fingers 65, 66, 67, which are very similar to the resilient fingers of the first embodiment. We disagree that it would have been obvious to make the fingers of either embodiment V-shaped in light of the teaching of Bieck. The fingers of Miller are oriented differently than Bieck’s holding jaws (unlike the fingers of Hartmann, which are oriented in the same manner as Bieck’s holding jaws). It is unclear how the flat, normally horizontal

fingers of Miller would be modified so as to have a V-shaped profile when viewed in a vertical plane. We conclude that Bieck would not suggest to a person of ordinary skill in the art modifying the normally horizontally oriented Miller fingers to have a V-shaped profile when viewed in a vertical plane.

We thus reverse the rejection of claim 21 as being obvious over the combination of Miller, Jackson and Bieck.

3. *Rejection of claim 22 based on Miller, Jackson, Bieck and Pratt*

The Examiner relies on Pratt to disclose a container holder having a spring means for biasing a support member. Ans. 6. The Examiner does not rely on Pratt to disclose a single supporting member that can be positioned below two openings or fingers having a V-shaped profile when viewed in a vertical plane. As such, the Examiner does not rely on Pratt to cure the above-noted deficiencies in the combination of Miller, Jackson and Bieck with regard to independent claim 21. Accordingly, we cannot sustain the Examiner's rejection of dependent claim 22 under 35 U.S.C. § 103(a).

CONCLUSIONS

The Examiner did not err in concluding that it would have been obvious to one skilled in the art at the time the invention was made to modify the container holder of Hartmann in view of the teachings of Jackson and Bieck.

The Examiner erred in concluding that it would have been obvious to one skilled in the art at the time the invention was made to modify the container holder of Miller in view of the teachings of Jackson and Bieck.

DECISION

The Examiner's rejection of claims 18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Hartmann in view of Jackson and further in view of Bieck is affirmed.

The Examiner's rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Jackson and further in view of Bieck is reversed.

The Examiner's rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Jackson and Bieck and further in view of Pratt is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED-IN-PART

mls